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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/712,465

11/13/2003

Peter Madsen

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9421

23650

7590

08/29/2006

NOVO NORDISK, INC.
PATENT DEPARTMENT
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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,465

Applicant(s)

MADSEN ET AL.

Examiner

Laura L. Stockton, Ph.D.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-16 are pending in the application.

Claim Objections

Claims 1-16 are objected to because of the following informalities:

It is suggested that Applicants check the spelling of each of the compounds listed in the claims {for example, the fifth compound listed on page 3 of the Amendment filed August 3, 2006}.

Appropriate correction is required.

Terminal Disclaimer

The terminal disclaimers filed on August 3, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration dates of 10/980,199 (if matures into a

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patent), U.S. Pat. 6,503,949 and U.S. Pat. 6,875,760 have been reviewed and are accepted. The terminal disclaimers have been recorded.

Rejections and objections made in the previous Office Action that do not appear below have been overcome by either the submission of terminal disclaimers, the disqualification under 35 USC § 103(c) of U.S. Pat. 6,503,949 for being commonly owned at the time the invention was made, or by amendments to the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the

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invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lau et al. {U.S. Pat. 6,503,949}.

Lau et al. disclose methods of using products that are the same as some of the products instantly claimed. See, for instance, the second compound in columns 499-500 of Lau et al. and the methods disclosed in column 40, lines 46-67. This compound in Lau et al. corresponds to the compound in, for example, instant **claim 1** on page 8 of the Amendment filed August 3, 2006, the sixth compound listed (see also page 15 of the instant specification, column 2, first compound listed).

Response to Arguments

Applicants' arguments filed August 3, 2006 have been fully considered but they are not persuasive.

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Applicants argue that the rejection of the claims is obviated by the deletion of the compound noted in the previous Office Action.

In response, Lau et al. is replete with compounds that anticipate each of the instant claims. In the previous Office Action, the Examiner noted one such compound but indicated by stating "See, for instance," that other compounds were disclosed in Lau et al. that also anticipated in the instant claimed invention. The following is a comparison list, which is not complete, of other specie which are disclosed in Lau et al. and are also found in the instant claims. For ease of comparison, Applicants will be directed to the instant specification, since it discloses both the nomenclature and structure of the compounds, but these compounds are also found in the instant methods of using claims.

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Applicants' compounds	Lau et al.'s compounds
claim 1, page 5, 3rd compound or page 8, column 2, 3 rd compound	Example 322 in column 232
page 15, column 1, 2 nd compound	1 st compound in columns 503-504
Page 15, column 2, 2 nd compound	2 nd compound in columns 503-504
Page 15, 1 st column, last compound	1 st compound in columns 505-506
Page 15, 2 nd column, 3 rd compound	1 st compound in columns 507-508
Page 15, 2 nd column, last compound	2 nd compound in columns 507-508

Therefore, the instant claimed invention is still found anticipated by Lau et al.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first

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reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

A handwritten signature in cursive script that reads "Laura L. Stockton". The signature is written in dark ink and is positioned above the printed name and title.

Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
Technology Center 1600

August 23, 2006